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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,158	03/05/2004	Scott A. Brown	H053699.0011US0	1051

1200 7590 05/17/2005

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44TH FLOOR  
HOUSTON, TX 77002

EXAMINER
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COONEY, JOHN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/801,158

Applicant(s)

BROWN, SCOTT A.

Examiner

John m. Cooney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12 and 21 is/are allowed.
- 6) ☐ Claim(s) 13-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Applicant's arguments filed 2-14-05 have been fully considered but they are not persuasive.

Objection to specification is withdrawn in light of applicants' observation it was in error. Rejection under 35 USC 103 is withdrawn in light of applicants' remarks. Obviousness-type double patenting rejection over 10/801,164 is withdrawn in light of applicants' properly filed terminal disclaimer.

The following are new or maintained:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13-16 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Gallagher (5,208,271).

Gallagher discloses methods for preparation of polyurethane foam materials including fillers prepared from isocyanates including polymeric MDI, polyols including amine-based polyether polyols and polyglycol polyols, and polyester polyols which read on esters, wherein the manner of combination of ingredients reads on the methods as claimed by applicants' (see the entire document).

Applicants' methods does not differentiate from combining the materials with a filler, and performing the processes of Gallagher in a subterranean location such as a basement or an in ground mold is readily envisioned from the teachings of Gallagher.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gallagher as applied to claims 13-16 and 18-20 above, and further in view of Murray et al.(5,951,796).

Gallagher differs from the claims in that 2,2,4-trimethyl-1,2-pentanediol diisobutyrate is not particularly required. However, Murray discloses the employment of these compounds in polyurethanes for the purpose of imparting their emulsifying and plasticizing effect in related two-component urethane forming materials (see column 5 lines 34-42, as well as, the entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the TXIB plasticizers of Murray et al. as processing aids in the processes of Gallagher for the purpose of imparting their emulsifying and plasticizing effect in order to arrive at the processes of applicants'

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claims with the expectation of success in the absence of a showing of new or unexpected results.

Applicant's arguments with respect to claims 13-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,521,673. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent # 6,521,673 discloses compositions, combinational methods, reactants and amount selections which vary from applicants' claims in a manner which would have been obvious to one having ordinary skill in the

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art. Looking to the specification of 6,521,673 for supporting disclosure provides the means for combining the materials of 6,521,673 and inclusion of additives with expectation of success such that distinction between the provided combinations of 6,521,673 and the methods of claims 13-20 of the instant application are not seen.

Claims 13-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-46 of copending Application No. 10/326,338. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ from each other in a manner and degree of combinational methods and selection which would have been obvious to one having ordinary skill in the art. Looking to the specification of 10/326,338 for supporting disclosure provides the means for combining the materials of 10/326,338 and inclusion of additives with expectation of success such that distinction between the provided combinations of 10/326,338 and the methods of claims 13-20 of the instant application are not seen.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants' arguments have been considered, but the rejections are maintained to be appropriately applied to claims 13-20.

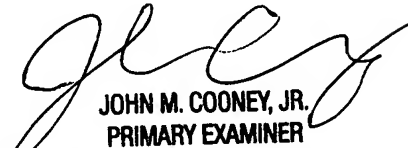
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JOHN M. COONEY, JR.  
PRIMARY EXAMINER  
